

AMENDMENT AND RESPONSE UNDER 37 C.F.R. 1.116

Serial No.: 09/655134

Filed: September 5, 2000

Title: METHOD AND APPARATUS FOR MOLDING A PLATE

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Docket No.: 1396.001US1

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on May 30, 2003, and the references cited therewith. No new matter is added by these amendments, and the Office has previously considered the scope of the claims as amended. Claim 10 has been amended to include some features formerly in claim 19 to more specifically claim Applicant's invention.

Claims 10-37 are amended; as a result, claims 1-37 are now pending in this application.

§102 Rejection of the Claims

Claims 10-11, 16-21, 26-28 and 30-34 were rejected under 35 USC § 102(b) as being anticipated by Osada et al. (U.S. 5,507,633). Applicant respectfully traverses this rejection and requests the Office to consider the following.

All the reasons for lack of anticipation, set forth in the amendment filed March 18, 2003, are incorporated herein by reference.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), M.P.E.P. §2131, 8th Ed., Rev. 1).

Independent claims 10 and 26 as amended include a preform comprising a thermosetting resin and at least about 50% by weight of a graphite filler material. The Office has admitted that during previous examination, it considered and gave patentable weight to the preform limitation (Office Action at page 5). Osada is devoid of this limitation. Because Osada does not teach, either expressly or inherently, the preform as claimed, these claims are not anticipated. Withdrawal of the rejections is respectfully requested.

§103 Rejection of the Claims

Claims 12-15, 22-25, 29 and 35-37 were rejected under 35 USC § 103(a) as being unpatentable over Osada et al., as applied to claims 10-11, 16-21, 26-28 and 30-34 in view of

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Swanson (U.S. 4,751,029). Applicant respectfully traverses this rejection and requests the Office to consider the following.

All the reasons for lack of obviousness, set forth in the amendment filed March 18, 2003, are incorporated herein by reference. The Office has admitted that during previous examination, it considered and gave patentable weight to the preform limitation (Office Action at page 5).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In *re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (M.P.E.P. § 2143 8th Ed, Rev.1).

Were Osada to include the graphite-filled resin as claimed in the instant application, his intended purpose would be destroyed due to shorting between leads through the graphite. An application of Osada to Swanson to combine and teach what is claimed by Applicant, exacerbates this shortcoming because Swanson teaches and prefers "reflective metallic particles uniformly distributed therein".

Regarding the first criterion, any purported motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings would be stifled by realization that any metallic particles in Swanson would destroy the purpose for Osada's technology. The motivation to combine Osada with Swanson therefore comes from Applicant's disclosure, and not from the references. Withdrawal of the rejections is respectfully requested.

Regarding the second criterion, Applicant respectfully disagrees that there would be any expectation of success (Office Action at page 4) in combining Osada with Swanson, that would overcome the destruction of Osada's technology thereby. The claimed subject matter as a whole is therefore not achievable by combination of Osada with Swanson, and expectation of success,

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if any comes from Applicant's disclosure and not from the combination of Osada with Swanson. Withdrawal of the rejections is respectfully requested.

Regarding the third criterion, Applicant notes that Osada and Swanson are devoid of at least of teaching the limitation of a graphite-filled preform as claimed. The references when combined, therefore do not teach or suggest all the claim limitations. Withdrawal of the rejections is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney John Greaves at 801-278-9171 (612), or the undersigned at 612-373-6970, to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

NEAL A. BENKOFKSKE ET AL.

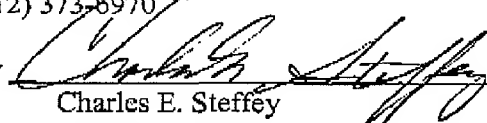
By their Representatives,

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September 2, 2003

By



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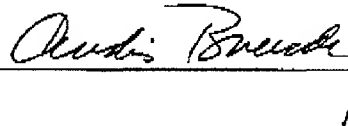
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The undersigned hereby certifies that this correspondence is being transmitted by facsimile (FAX NO. 703-872-7311) to:
Attn.: Examiner Thukhank Nguyen, GAU 1722, Mail Stop AP, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this
2nd day of September, 2003 (Tuesday following a Federal holiday).

Candis B. Buending

Name

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